

**Appeal Brief**

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Dated: November 30, 2009

Signature:

(Donna Forbit)

Docket No.: 66729/P028US/10613659  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Roy Schoenberg

Application No.: 10/825,352

Confirmation No.: 8650

Filed: April 15, 2004

Art Unit: 3686

For: RULE MANAGEMENT METHOD AND  
SYSTEM

Examiner: V. D. Koppikar

**RESPONSE TO NOTIFICATION OF  
NON-COMPLIANT APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Response is filed to address the informalities cited in the Notification of Non-Compliant Appeal Brief dated November 18, 2008 (the "Notice"). The Notice contends that the Appeal Brief filed October 9, 2009 is non-compliant under 37 C.F.R. 41.37(c)(1)(ix) because it "does not contain copies of the evidence submitted ... or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto". Appellant respectfully disagrees and submits that the Appeal Brief was fully compliant with 37 C.F.R. 41.37, as discussed further below. Therefore, the Notice should be withdrawn and the Appeal Brief should be deemed accepted for proceeding with the appeal.

**I. The appeal brief contains an evidence appendix and the evidence being submitted**

First, the Appeal Brief included an appendix that identified the evidence being submitted and relied upon by Appellant, *see* the Evidence Appendix on page 43 of the Appeal Brief

(identifying the Declaration of Roy Schoenberg as being submitted with the Appeal Brief).

Further, a copy of the evidence being relied upon was also submitted with the Appeal Brief, *see* the Declaration of Roy Schoenberg and the accompanying Appendix A thereto that accompanied the Appeal Brief. Further, the arguments presented in the Appeal Brief on pages 31-32 explained how Appellant relies upon the evidence being submitted. Specifically, the Declaration of Roy Schoenberg is relied upon to evidence that the newly-applied *Claud* reference (which was first applied in a new ground of rejection introduced in the Office Action dated June 11, 2009 from which the present appeal was taken, as explained at pages 3-4 of the Appeal Brief) is not prior art that may be used in rejecting the claims 12-28 and 35-40.

**II. The evidence was not previously entered, but should be admitted because it addresses a new ground of rejection that was initially raised in the Final Office Action from which the present appeal is taken**

As for the contention that the Appeal Brief lacks a statement setting forth where in the record that evidence was entered by the examiner, Appellant respectfully notes that the evidence is newly submitted and thus was not previously entered. However, while the evidence was not previously entered, the evidence should nevertheless be admitted under 37 C.F.R. 41.33(d)(1), which provides:

An affidavit or other evidence filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

Here, there is certainly good and sufficient reasons why the evidence was not earlier presented. For instance, the evidence was not earlier presented because the present Appeal is taken responsive to the Final Office Action dated June 11, 2009 which first applied the *Claud* reference in rejecting claims 12-28 and 35-40. Thus, the Appeal Brief was Applicant's first opportunity to respond to this new ground of rejection. As such, the evidence was not earlier presented as this new ground of rejection was not earlier raised by the Examiner.

Appellant notes that, as explained on pages 3-4 of the Appeal Brief, the present application has been repeatedly rejected in Final Office Actions with new grounds of rejection being raised each time. Indeed, the Final Office Action of June 11, 2009 (from which the present appeal is taken) which raised a new ground of rejection relying upon *Claud* was the third such modified rejection. Because Appellant has overcome each previous ground of rejection and maintains that this new ground of rejection is improper (but has continued to face repeated new grounds of rejection), Appellant elected to appeal the new ground of rejection to the Board. Pursuant to 37 C.F.R. 41.31, "Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board". Appellant further notes that other grounds of rejection that are not based upon *Claud* (and for which the submitted evidence is not relied upon) continue to be maintained for claims 1-17 and 28-35, *see* the Grounds of Rejection to be Reviewed on Appeal on page 12 of the Appeal Brief. Appellant thus elected to appeal those grounds of rejection to the Board as Appellant has repeatedly maintained that those grounds of rejection are improper.

Thus, the appeal is proper in the present application because the claims have been repeatedly rejected (more than twice). And, as discussed above, Applicant did not have an opportunity to previously enter the evidence because the present appeal was taken responsive to the new ground of rejection of claims 12-28 and 35-40 based on *Claud* initially being raised by the Examiner. Thus, Appellant should be afforded the opportunity to fully address the new ground of rejection of claims 12-28 and 35-40 on appeal with admission of the submitted evidence.

As mentioned above (and as explained in the Appeal Brief at pages 3-4), the rejection of claims 12-28 and 35-40 has repeatedly changed in multiple Final Office Actions. If Appellant were required to first submit the evidence and argue this new ground of rejection of claims 12-28 and 35-40 prior to taking appeal, Appellant will continue to be stalled in appealing the other grounds of rejection that have been raised for claims 1-17 and 28-35. Thus, Appellant should be permitted to proceed with the appeal of the claims. Also, to afford Appellant a full and fair opportunity to respond to the new grounds of rejection that are based on *Claud*, the submitted

evidence should be admitted. If the Examiner finds the evidence and arguments presented for claims 12-28 and 35-40 persuasive but maintains the other grounds of rejection, the Examiner may indicate in the Examiner's Answer that the new grounds of rejection are withdrawn and the appeal may proceed to the Board for a determination as to the other outstanding grounds of rejection (instead of further delaying Appellant's ability to appeal such other grounds of rejection that are raised for claims 1-17 and 28-35).


In addition, the evidence should be admitted because, for the reasons explained in the appeal brief (at pages 31-32 thereof), the evidence overcomes the newly-introduced ground of rejection that relies upon the *Claud* reference.

Therefore, the evidence submitted with the Appeal Brief should be admitted, and the Notice of Non-Compliant Appeal Brief should be withdrawn for the above reasons.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3948, under Order No. 66729/P028US/10613659 from which the undersigned is authorized to draw. Please charge any additional fees required or credit any overpayment to Deposit Account 50-3948 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: November 30, 2009

Respectfully submitted,

By   
Jody C. Bishop  
Registration No.: 44,034  
FULBRIGHT & JAWORSKI L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
(214) 855-8007  
(214) 855-8200 (Fax)  
Attorney for Applicant